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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,886	09/04/2003	Kimmo Laakkonen	915-006.021	1554
4955 7590 09/28/2007 WARE FRESSOLA VAN DER SLUYS & ADOLPHSON, LLP BRADFORD GREEN, BUILDING 5 755 MAIN STREET, P O BOX 224 MONROE, CT 06468			EXAMINER WHIPPLE, BRIAN P	
			ART UNIT 2152	PAPER NUMBER
			MAIL DATE 09/28/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/656,886

Applicant(s)

LAAKKONEN, KIMMO

Examiner

Brian P. Whipple

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-9 and 14-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-9, and 14-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-2, 4-9, 14-25 are pending in this application and presented for examination. Claim 10 was cancelled by applicant's amendment on 9/7/07.

Response to Arguments

2. Applicant's arguments with respect to the drawing objections, the claim objections to claims 21 and 25, the 35 U.S.C. 101 rejection of claim 10, and the 35 U.S.C. 112, second paragraph rejection of claim 16 have been fully considered, are persuasive, and have been withdrawn.

3. Applicant's arguments with respect to the objections to claims 8-10 and 21-25 have been fully considered but they are not persuasive.

As to claim 8, the claim is directed to neither a "method" nor a "software tool... stored on a computer readable medium," but rather embrace or overlap both a product and a process. See *IPXL Holdings v. Amazon.com, Inc.*, 430 F.2d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005; *Ex parte Lyell*, 17 USPQ2d 1551 (Bd. Pat. App. & Inter. 1990).

Claims 9 and 22-24 are objected to for similar reasons as claim 8.

4. Applicant's arguments with respect to the 35 U.S.C. 102 rejections of claims 1-2, 4-9, and 14-25 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

5. As to claim 8, the claim is directed to neither a "method" nor a "software tool... stored on a computer readable medium," but rather embrace or overlap both a product and a process. See *IPXL Holdings v. Amazon.com, Inc.*, 430 F.2d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005; *Ex parte Lyell*, 17 USPQ2d 1551 (Bd. Pat. App. & Inter. 1990).

6. Claims 9 and 22-24 are objected to for similar reasons as claim 8.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-2, 4-9, and 14-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Theimer et al. (Theimer), U.S. Patent No. 5,493,692, in view of what is well known in the art.

9. As to claim 1, Theimer discloses a method for controlling the handling of push type e-mails on a mobile terminal device (Abstract), comprising:

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determining the status of a user profile (Col. 25, ln. 17-26), said user profile regarding the handling of push type e-mails on said mobile terminal device (Col. 25, ln. 17-26, 46-51, and 55-57), wherein said determined user profile status comprises push type e-mails enabled or push type e-mail disabled (Col. 25, ln. 46-51), and

controlling at said mobile terminal device (Col. 25, ln. 55-57; "a user may specify...") the handling of push type e-mails according to said determined user profile status (Col. 25, ln. 46-51).

Theimer discloses a user specifying preferences related to the delivery of messages (Col. 25, ln. 55-57) and a user profile (Fig. 3, item 102) depicting the wishes of the user (Col. 25, ln. 23-26) is examined by a UserAgent (Col. 25, ln. 21-23).

Additionally, Theimer discloses that the user's preferences are stored in a user profile (Col. 9, ln. 54-55) and that the UserAgent is running "on some trusted computer or computers on the network" (Col. 9, ln. 49-53). It would have been obvious to one of ordinary skill in the art at the time of the invention to interpret the user profile as being stored on the mobile terminal device, as the user profile is separate from the UserAgent as discussed above. Theimer fails to explicitly disclose where the user profile is stored, and therefore it would be natural to assume the profile is stored on the user's mobile terminal device itself, as it is defined by the user and specifies the user's preferences, and the UserAgent "may obtain information about the user from user profile **102** at startup time" (Col. 9, ln. 55-59) as opposed to stating that the user profile is integrated in the UserAgent as implied by the applicant's remarks. Additionally, it is implied the user

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profile is separate from the UserAgent, because when a user changes preferences the "changing of the profile file and alerting the UserAgent" occur (Col. 10, ln. 3-7).

Furthermore, a person of ordinary skill in the art, upon reading Theimer, would have recognized the need to store the user profile in a system, especially given Theimer's disclosure that the user's preferences are stored (Col. 9, ln. 54-55). There are a finite number of systems in the teachings of Theimer that may be used to store the user profile. It would have been obvious to one of ordinary skill in the art at the time of the invention to try storing the user profile at the mobile terminal device of the user; as a person with ordinary skill in the art has good reason to pursue the known options within his or her technical grasp.

10. As to claim 2, Theimer and what is well known in the art discloses the invention substantially as in parent claim 1, including said controlling of the handling of push type e-mails comprises notifying a push type e-mail server of a mobile communication network about the handling of push type e-mails according to said determined user profile (Theimer: Fig. 1; Fig. 17; Col. 24, ln. 49-60).

11. As to claim 4, Theimer and what is well known in the art discloses the invention substantially as in parent claim 1, including said user profile comprises a predetermined filter acting on the received push type e-mails (Theimer: Col. 25, ln. 23-26 and 52-57), said filter selecting push type e-mails according to properties of said received emails (Theimer: Col. 25, ln. 23-26 and 52-57), wherein said method further comprises:

receiving a push type e-mail (Theimer: Col. 25, ln. 6-12), and
filtering said received e-mail according to said properties (Theimer: Col. 25, ln. 23-26 and 46-57).

12. As to claim 5, Theimer and what is well known in the art discloses the invention substantially as in parent claim 2, including storing said received push type e-mail (Theimer: Fig. 17, items 430, 432, and 436; Col. 25, ln. 46-51; it may be interpreted that if the application waits for a change in context before reattempting delivery that it must store the e-mail until the reattempt)

13. As to claim 6, Theimer and what is well known in the art discloses the invention substantially as in parent claim 1, including said terminal device further comprises sensors (Theimer: Fig. 1; Col. 12, ln. 62-66), said method further comprising:

determining of sensor data (Theimer: Fig. 1; Col. 12, ln. 62-66), and
changing said user profile according to said determined sensor data (Theimer: Fig. 1; Col. 9, ln. 64 – Col. 10, ln. 7; Col. 12, ln. 62-66; Col. 25, ln. 17-26).

14. As to claim 7, Theimer discloses a method for controlling the handling of push type e-mails destined for mobile terminal devices on a push type e-mail server (Abstract; Fig. 1; Fig. 17; Col. 24, ln. 49-60) comprising:

storing at least one user profile related to each of a plurality of mobile terminal devices (Abstract, ln. 1-8, "user or users"; Fig. 2, items 70 and 72; Fig. 3, item 102; Col.

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25, ln. 17-26), each user profile regarding the handling of push type e-mails destined for one of said plurality of mobile terminal devices (Col. 25, ln. 23-26 and 46-57),

receiving at the push type e-mail server a notification from any of said plurality of terminal devices related to at least one user profile related to said any mobile terminal device (Fig. 1; Col. 10, ln. 3-7; Col. 25, ln. 17-26 and 55-57), and

handling by said server push type e-mails destined for said terminal device according to said received notification related to said at least one user profile related to said any terminal device (Col. 25, ln. 46-57).

Theimer may be interpreted as being silent on storing the user profiles at the e-mail server. However, a person of ordinary skill in the art, upon reading Theimer, would have recognized the need to store the user profile in a system, especially given Theimer's disclosure that the user's preferences are stored (Col. 9, ln. 54-55). There are a finite number of systems in the teachings of Theimer that may be used to store the user profile. It would have been obvious to one of ordinary skill in the art at the time of the invention to try storing the user profile at the e-mail server, as a person with ordinary skill in the art has good reason to pursue the known options within his or her technical grasp.

15. As to claim 8, Theimer and what is well known in the art disclose a software tool comprising program code means stored on a computer readable medium for carrying out the method of claim 1 (Col. 8, ln. 52-58; see the rejection of claim 1 above), when said software tool is run on a computer or network device (Col. 8, ln. 52-58).

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16. As to claims 9-10, the claims are rejected for the same reasons as claim 8 above.

17. As to claims 14-15, the claims are rejected for the same reasons as claim 1 above.

18. As to claim 16, the claim is rejected for the same reasons as claim 4 above.

19. As to claim 17, the claim is rejected for the same reasons as claim 2 above.

20. As to claim 18, the claim is rejected for the same reasons as claim 6 above.

21. As to claim 19, the claim is rejected for the same reasons as claims 1-2 above.

22. As to claim 20, Theimer discloses said e-mail server is an external mailbox capable of receiving push type e-mails (Col. 24, ln. 49-60; Col. 25, ln. 6-12 and 46-51).

23. As to claim 21, the claim is rejected for the same reasons as claims 14 and 19 above.

24. As to claim 22, the claim is rejected for the same reasons as claims 7-8 above.

25. As to claims 23-24, the claims are rejected for the same reasons as claim 22 above.

26. As to claim 25, the claim is rejected for the same reasons as claims 15 and 20 above.

Conclusion

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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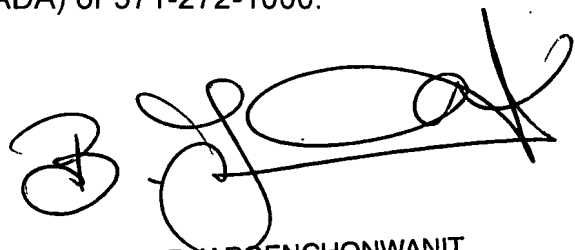
28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Whipple whose telephone number is (571) 270-1244. The examiner can normally be reached on Mon-Fri (8:30 AM to 5:00 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BPW

Brian P. Whipple
9/24/07



BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER

9/28/07